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In re Application of :
Richard A. Schumaker et al :
Serial No.: 10/622,833 : PETITION DECISION
Filed: July 21, 2003 :
Attorney Docket No.: MEMORY-28 :

This is in response to the petition under 37 CFR 1.144, filed April 2, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on February 11, 2003, and contained claims 1-113. In a first Office action, mailed September 1, 2005, the examiner required restriction between the inventions claimed, as follows:

Group I – Claims 1-7, 21-22, 36-37, 51-52, 66-67, 81-82, 96-97 and 111-113 drawn to products of Formula I;

Group II – Claims 8-20, 23-35, 38-50, 53-65, 68-80, 83-95 and 98-110 drawn to methods of use of the products of Formula I.

An election of species of the condition to be treated was required for Group II as well as an election of a single compound (species) for either Group.

The examiner reasoned that the inventions were distinct based on the wide variety of definitions for R1-R4 which give rise to many permutations and combinations and a reference anticipating one species would not anticipate or render obvious another. The examiner advised of rejoinder of non-elected method claims with allowable elected product claims.

Applicants replied on September 22, 2005, electing Group I and a species with traverse. Applicants commented that it was presumed that the examiner would follow the guidelines of M.P.E.P. 803.02 with regard to the election of species and not further restrict within the claims.

The examiner mailed a new Office action to applicants on December 20, 2005, maintaining the restriction requirement and maintaining that there were a large number of independent and distinct inventions encompassed within the product claims. The examiner then defined the limit of each variable R¹-R⁶ and L in claim 1 and indicated that products outside the scope of the limits were considered non-elected and withdrawn. The examiner then objected to the claims for containing non-elected subject matter and rejected the claim under 35 U.S.C. 112, second paragraph, as indefinite, under 35 U.S.C. 102(e) as anticipated and under 35 U.S.C. 103(a) as unpatentable and for obvious double patenting.

Applicants filed a reply on February 15, 2006, amending claims 8, 11 and 16-20 to be independent, replacing canceled claim 1, and again traversing the restriction requirement and the examiner's limitation of the claims. All other rejections were responded to appropriately..

The examiner mailed a series of non-compliant amendment letters to applicants on April 27, 2006, July 26, 2006, and September 8, 2006, requiring revision of the amendments to the claims to be in compliance with 37 CFR 1.121. Applicants replied timely to each request. The examiner mailed a Final Office action to applicants on January 16, 2007, withdrawing all rejections of record. The examiner continued to maintain the restriction requirement and limitation of the claims as previously set forth and objected to the allowed product claims as containing non-elected subject matter needing to be canceled.

Applicants filed a reply to the Office action on April 2, 2007, and this petition requesting withdrawal of an improper restriction requirement.

DISCUSSION

The examiner's last Office action mailed January 16, 2007, indicates all elected product claims allowable, but objected to as containing non-elected subject matter. The examiner appears not to have considered the non-elected method claims for rejoinder.

Applicants argue that the examiner's limitation of the variables, as set forth in the Office action mailed December 20, 2005, is improper and cite *In re Weber*, *In re Hozumi*, *In re Harnish* and *In re Haas* for support. These same cases were cited in the traversal of the examiner's limitation of the claims. Applicants argue that where there is a common core shared by all compounds and a common utility associated with that core restriction within a claim is improper. The examiner dismissed each of these cases as not applying to the instant application or examiner action since no rejection under 35 U.S.C. 121 had been made and the cases were, therefore, not relevant. As argued by applicants, the examiner has not applied this well-defined test to the instant claims.

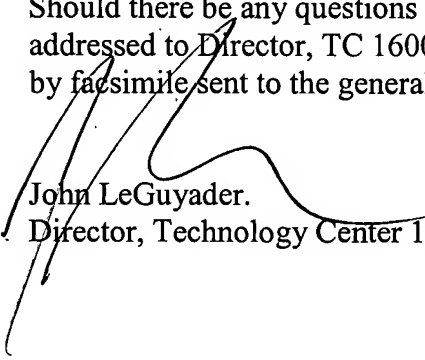
As can be seen from the formula in claim 1, the basic structure is a benzene ring with two OR substituents attached ortho to each other and a disubstituted amino substituent para to one of the OR groups. Each R group is well-defined and encompasses many possible substitutions. However, the common core remains the same. This satisfied the requirement of M.P.E.P. 803.02 and the examiner must follow the guidelines therein having made an election of species requirement. No provision is made therein for examiner limitation of applicants' claims. The examiner's objection to the product claims containing non-elected subject matter is in error.

DECISION

The petition is **GRANTED**. The election of species requirement by the examiner is acknowledged as is the determination that the species elected is allowable. Based upon this the examiner must extend the examination to additional species to determine the allowability of the genus.

The application will be forwarded to the examiner for consideration of applicants' reply to the Final Office action filed April 2, 2007, commensurate with the above decision. In addition, the Finality of the previous Office action is considered premature in view of the claim limitations imposed by the examiner in error and failure to consider rejoinder of method claims upon allowance of product claims and is hereby withdrawn.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.



John LeGuyader.
Director, Technology Center 1600